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In re Application of :
Leonard et al. :
Serial No.: 09/708,352 : PETITION DECISION
Filed: November 08, 2000 :
Attorney Docket No.: 02108.0001U2 :

This is in response to the petition under 37 CFR 1.181, filed March 07, 2008, requesting that the Notification of Non-Compliant Appeal Brief, dated February 5, 2008, be withdrawn.

BACKGROUND

A review of the file history shows that a Final Rejection on the pending claims 1, 3-12 and 29-56 was mailed to applicants on May 25, 2008. The rejections maintained in the Final Rejection are:

1. Claims 1, 3, 5, 6, and newly submitted claims 29, 30, 40-44 and 52-55 are rejected under 35 U.S.C. 102(b) as anticipated by Boothby, (Immunologic Responses to Mycoplasma bovis, University Microfilm International (Dissertation) 1-172, 1982).
2. Claims 1, 4, 5, 7, and newly submitted claims 29-30 and 56 are rejected under 35 U.S.C. 102(b) as anticipated by Thorns et al (Res. Vet. Sci., 1980, 29(3), 328-332).
3. Claims 1, 3-12 and newly submitted claims 29-56 are rejected under 35 U.S.C. 103(a) as unpatentable over Boothby (Immunologic Responses to Mycoplasma bovis, University Microfilm International (Dissertation) 1-172, 1982) in view of Poumarat et al (Veterinary Microbiology, 40, 1994, 305-321) further in view of Thorns et al (Res. Vet. Sci., 1980, 29(3), 328-332).

In response to the Final office action, applicants submitted an amendment, together with a Notice of Appeal on October 27, 2005. Additionally, applicants filed a Decision on Appeal from the proceedings of Ex Parte Hervy A. Morris, on October 27, 2007, as a courtesy to the Examiner.

On February 15, 2006, the Examiner issued an Advisory Action and did not enter the amendment stating that the newly added limitation presented issues that would require further consideration and/or search. The Examiner stated that the amendment added limitations to the claims, for example, "...and the vaccine does not cause unfavorable reactions" that have not been searched and considered before the submission of the after-final amendment. The advisory action further

stated that since applicant's arguments are predicated on an amendment not made of record, said arguments are deemed non-persuasive.

In response to the Advisory action of February 15, 2006, applicants filed an Appeal Brief dated May 26, 2006. The Appeal Brief stated that the After-final amendment presented on February 15, 2006 was not entered. In the Appeal brief, applicants argued the rejections maintained in the Final rejection. It is argued that the rejection of record failed to anticipate or render the instant claims obvious on the basis that the cited prior art of Boothby and Thorns et al. produces very unfavorable reaction (pages 11 and 19 of the Appeal Brief) and also is protective against *Mycoplasma bovis* mastitis. Applicants presented several case laws, including *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F. 3d 989, 54 U.S.P.Q. 2d 1227 (Fed. Cir. 2000) and *Ex Parte Hervy A. Morris*, to show that the prior art cited is not capable of performing the function "protective against *Mycoplasma bovis*", which limitation the examiner construed as an intended use. Additionally, applicants referred to several prior art references (listed in the Evidence Appendix section of Appeal Brief and are of record), in support of their argument.

On February 5, 2008, a Notification of Non-compliant Appeal Brief was mailed to applicants stating that the Appeal Brief filed on May 26, 2006 acknowledges that even though applicants acknowledge that the after-final amendment filed October 24, 2005 was not entered, they presented arguments in the Appeal Brief that have not been previously considered. The Notification referred to pages 15-18 of the Appeal Brief. Further, applicants have been advised in the Notification that the affidavit or other evidence; for example, new arguments filed after the final action, but before or on the date of filing a Notice of Appeal will not be entered because applicants failed to provide a showing of good and sufficient reasons why the affidavit or other evidence was necessary and was not earlier presented. See 37 CFR 1.16(e).

In response to the Notification of Non-compliant Appeal Brief, applicants filed a petition under 37 CFR 1.181, on March 07, 2008, requesting that the Notification of Non-compliant Appeal Brief, issued February 5, 2008 be withdrawn.

DISCUSSION

Applicants submit that the Notification of Non-compliant Appeal Brief was issued in error and request that it be withdrawn because:

- (1) Only new evidence, not new arguments, is forbidden by 37 C.F.R. §41.37 and 1.116(e). The Appeal brief contains no new evidence.
- (2) Even if new arguments were forbidden, the Appeal Brief contains no new arguments.

Applicants argue that pages 15-18 of the Appeal Brief contain no amendment to the specification or claims, no affidavit, and no new citation of evidence. It is argued that 37 C.F.R. §41.37(c)(2) and 37 C.F.R. § 116(e) provide no support for the issuance of the Notification of Non-compliant Appeal Brief.

Applicants submit that The Notification of Non-compliant Appeal Brief did not specify which item or items on page 15-18 were considered to be new evidence. According to applicants, the evidence appendix of the Appeal Brief lists 8 items, of which items 1-4 and 6-8 are listed

together with citations to where those items appeared in the record, and item 5 is a copy of *Ex parte Hervy V. Morris*, provided as a courtesy to the examiner at the time of the filing After-Final amendment.

Applicants also submit that the arguments discussed on pages 15-18 of the Appeal Brief pertain to the functional language (“protective against *Mycoplasma bovis mastitis*”) of the claims, whether the limitation serves to distinguish over the prior art, and that the discussion of the case laws i.e., *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F. 3d 989, 54 U.S.P.Q. 2d 1227 (Fed. Cir. 2000) and *Ex Parte Hervy A. Morris* only supports their position over the disputed claim language. Applicants submit that the arguments discussed on pages 15-18 of the Appeal Brief were also discussed in the Amendment before the Final Rejection has been issued, for instance, along with the Amendment filed March 29, 2004 (exhibit C) and hence are clearly a part of the record. Applicants argue that the fact that the arguments on pages 15-18 of the Appeal Brief were also discussed in the Amendment after Final does not change the fact that this argument had been raised by applicants long before the Final Rejection had been issued and that it is, therefore, not a new argument.

Applicants’ arguments are found be persuasive because:

37 C.F.R. §41.37(c)(2) states:

(2) A brief shall not include any new or non- admitted amendment or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

37 C.F.R. §116(e) states:

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or "an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

The Notification of Non-Compliant Appeal Brief refers to 37 C.F.R. §1.16(e) which appears to be a typographical error. It should have recited 37 C.F.R. §1.116(e).

A careful review of the Appeal Brief in general and pages 15-18 in particular, does not reveal any new line of evidence. The Appeal Brief (on page 6) clearly acknowledges the fact that the amendments presented after Final Rejection have not been entered. The arguments presented in the appeal brief (pages 15-18) pertain only to the functional language of the claims, i.e. “protective against *Mycoplasma bovis mastitis*” and not to the amendments submitted in the After-Final Amendment. Applicants provided a comparison between the instant claims that recite the above functional language and the case of *Union Oil Co.*, on page 16 of the Appeal brief. In this regard, applicants directed the Examiner’s attention to page 2, lines 1-11 and page 19, lines 17-32 of the instant application, to emphasize that, as in *Union Oil Co.* case, the instant specification stresses the problem of mastitis and that the data provided in the instant specification addresses and provides vaccination for the problem of mastitis. Thus, it is apparent that the data referred to on pages 15-18 of the Appeal Brief is already of record (cited from the instant specification) and therefore does not constitute any new evidence. The discussion on

page 17 of Appeal Brief is also directed to the above limitation and the argument whether the prior art is capable of performing the intended use was presented in light of *Ex Parte* Hervy A. Morris. Thus, it is considered that the discussions on pages 15-18 of the Appeal Brief do not refer to the amendments presented after the Final Rejection. The argument that the instant vaccines do not cause unfavorable reactions was repeatedly presented by applicants even before the filing of the Appeal brief. For instance, page 14 of the Response submitted on August 19, 2004, which is in response to the Non-Final Rejection of September 30, 2004, also presents the same argument. Hence, the argument that the vaccine does not cause unfavorable reactions is not new. Thus, the Appeal Brief filed on May 26, 2008 neither presented new evidence nor presented arguments that have not been considered before.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for consideration of the Appeal Brief filed May 26, 2007.

Should there be any questions about this decision please contact Ms. Marianne Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.



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